UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,263	09/15/2003	Patrick H. Hayes	81230.38US4	9025

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GREENBERG TRAURIG, LLP
77 WEST WACKER DRIVE
SUITE 2500
CHICAGO, IL 60601-1732

EXAMINER
ZIMMERMAN, BRIAN A

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PTO-90C (Rev. 10/03)

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/662,263
Filing Date: September 15, 2003
Appellant(s): HAYES ET AL.

MAILED

MAR ⁹ 2006

GROUP 2800

Gary R. Jarosik
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/17/06 appealing from the Office action

mailed 9/15/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The examiner agrees with the appellant's statement regarding the status of the claims.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5679945	Renner	10-1997
5315392	Ishikawa	05-1994
5138649	Krisbergh	08-1992
WO 9409570	Parienti	04-1994

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1.   Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pariente (WO 9409570) and Renner (5679945).

Pariente teaches a remote controller 1 that includes a readable media storage device 11 (chip-card) on which a microcircuit 12 is contained. Parameter codes defining or describing different electronic devices (the codes being stored on the chip card in memory which is inherently non-volatile) are read by the remote controller under the control of the microprocessor 15, internal to the remote controller 1, thereby programming the remote controller (abstract). Card 11 is inserted into slot 10. The card is removable and inherently includes electrical contacts in order for the remote controller to accept electrically transferable codes or commands.

The card programs the remote controller 1. The remote controller 1 accordingly now stores the codes/commands, the card is removed and the remote controller accesses internal memory EEPROM 18 to retrieve the codes/commands for operating a first (and subsequent different) electronic equipment.

In an analogous art, Renner teaches an intelligent card reader. In order to prevent unauthorized use of the smart card the card is programmed with limitations such as the number of times the card can be used or having a preprogrammed expiration date. See col. 11 lines 30-35 that specifically states that the ICR (card) can be programmed to make access based on other parameters. This is interpreted that on the card is stored (programmed) parameters that can limit access. Limiting access is interpreted as a form of limiting use of the code data as claimed. When the card is limited by the number of times it can be used to operate the regulated feature, the code data from the card is only read a number of times. The ICR card can be programmed (is modifiable) by the reading device to count down the value of access attempts, see col. 13 lines 30+. The claims do not specify that all the data is not read or data is prevented from being read. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have used an operation limitation to the number of times the Parienti card can be used in order to prevent unauthorized use of the card to protect against unauthorized use.

(10) Response to Argument

The appellant argues that Renner is non-analogous art. In order for the reference to be analogous art, for the purpose of rejections, the reference can fit the category of being pertinent to the particular problem being solved or be in the field of endeavor. Here Renner is pertinent to the problem of authorization, validity and security. The appellant's specification (paragraph 43 of PGPUB 2004/0056984) states that a concern or problem addressed by the appellant is validity and security. Since Renner deals with validity and security problems, it is analogous art. Additionally, Renner meets the analogous art arena by being in the field of endeavor, namely the use of Smart Cards for programming. Both the appellant's specification and Renner use Smart Cards for programming and controlling other devices.

The appellant argues that Renner does not describe a readable media that has data stored thereon where the data is modifiable by a reading device, for the purpose of limiting the use of other data. Col. 13 lines 30+ of Renner uses a count to limit the number of times the "other data" can be used from the data card. The count limit is on the card and modified by the reader. Therefore, Renner does describe a readable media that has data stored thereon where the data is modifiable by a reading device, for the purpose of limiting the use of other data.

The appellant argues that Renner does not suggest the modification of Parienti. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958

F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The references do not need to specifically

suggest modification of each other. In this case, Renner suggests protecting data on

the card from unauthorized use (col. 11 lines 15-35) and such would be helpful to the

Parienti system.

For the first time, the appellant argues that the references do not show the data

on the card functions to add codes to the remote control. Parienti teaches such a

feature in that the card effectively adds possible codes that the remote controller can

transmit to the appliance or television.

For the first time, the appellant argues that the references do not show the data

on the card functions to allow remote control access to limited access programming.

Since Parienti teaches that the codes on the data card are used to send control signals

to a television. Televisions are typically used to convey channels received through

CATV or Satellite systems and these broadcast media need to be paid for through a

subscription, the broadcasts displayed on the television are 'limited access

programming." Therefore, controlling the television to change to ESPN would meet the

claim limitations of allowing remote control access to limited access programming.

For the first time, the appellant argues that the references do not show the data

on the card functions to allow remote control access to allow timed access to limited

access programming. Renner is cited for limiting the access granted by the codes in

the card by a programmed expiration date. Therefore the combination does teach

allowing remote control access to allow timed access. As discussed above the access can be to 'limited access programming.'

For the first time, the appellant argues that the references do not show the data on the card functions to allow remote control access to allow a predetermined number of accesses to limited access programming. Renner is cited for limiting the access granted by the codes in the card by a programmed expiration number of times. Therefore the combination does teach allowing remote control access to allow timed access. As discussed above the access can be to 'limited access programming.'

For the first time, the appellant argues that the references do not show the data on the card functions to allow remote control access to enable access to a code stored within the remote control. The number of times permitted by Renner's system is stored on the card and counted down and updated by the reader (col. 13 lines 30+).

(11) Related Proceeding(s) Appendix

The applicant has submitted all (none) related proceedings

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Brian Zimmerman

BRIAN ZIMMERMAN
PRIMARY EXAMINER

Conferees:
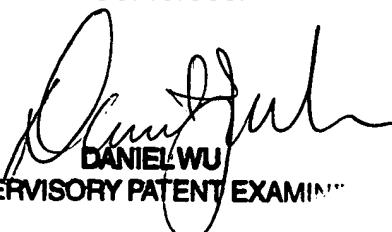
DANIEL WU
SUPERVISORY PATENT EXAMINER

MICHAEL HORABIK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

EDWIN C. HOLLOWAY III
PRIMARY EXAMINER